

REMARKS

The Applicant notes the examiner's election/restriction requirement and claim rejections and respectfully requests reconsideration and withdrawal of same in light of the following discussion.

Traversal of Election/Restriction Requirement

The Applicant traverses and requests reconsideration and withdrawal of examiner's restriction requirement, pursuant to 37 CFR § 1.143. Provisional election of the invention as claimed in Claims 1-26 is made.

The Applicant respectfully submits that Claims 27-80 presented previously should not be withdrawn from consideration because they are not directed to an independent and distinct invention from Claims 1-26. 37 CFR § 1.145 states that “[i]f after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144” (emphasis added).

Claims 27-54 are directed to a process of using the system claimed in Claim 1, and Claims 55-75 are directed to a process of using the system claimed in Claim 15. Claims 76-80 depend on Claim 14. Such claims are dependent claims, depending on Claim 1, Claim 15 or Claim 14, as applicable. Clearly the invention as claimed in Claims 27-80 cannot be considered to be directed to an *independent* invention when they expressly depend on Claim 1, Claim 15, or Claim 14 as applicable.

Furthermore, in order to establish that a product (as claimed in Claims 1 and 15) and a process of using the product (as claimed in Claims 27-54 and 55-75, respectively), are *distinct*

inventions, either or both of the following must be shown: (A) the product of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. MPEP § 806.05(h). There has been no showing to satisfy such requirement. The Office Action includes no application or mention of this test, merely stating conclusorily that the added claims are directed to an independent or distinct invention. The examiner has simply referred to the word “advertising” in the preamble of such claims without any explanation of the effect of such words. “The claim preamble must be read in the context of the entire claim.” MPEP § 2111.02. In the present case the word “advertising” in the preamble is apparently being considered by the examiner to be a claim limitation significant to construction of Claims 27-80, while the dependence of such claims to Claims 1, 14 or 15 as applicable is not be considered. The Applicant respectfully submits that the word “advertising” in the preamble is not a distinct definition of the claimed invention’s limitations and is not of significance to the determination of whether Claims 27-80 are independent and distinct. See MPEP § 2111.02. Additionally, with respect to Claims 76-80 in particular, which depend on method Claim 14, said claims merely add steps to method Claim 14 and should be treated as other dependent claims. Furthermore, the word “advertising” has been deleted by amendment herein by the Applicant. Claims 1-26 already include both method and system claims, none of which were required to be elected between by the prior examiner in the first office action, and Claims 27-80 are completely related and directed to one and the same invention and do not impose any undue burden in being reviewed with Claims 1-26.

Rejections Based on 35 U.S.C. § 112, Second Paragraph

The Applicant has further noted the examiner’s rejection of Claims 1-26 under 35 U.S.C. § 112, second paragraph and requests reconsideration and withdrawal of said rejection.

The Applicant notes that wording “comparable alternatives” has been in Claims 1, 14 and 15 since filing of the present application and was not an issue in the prior office action and was apparently sufficiently clear enough to the prior examiner in order for her to issue the prior Section 102(b) rejection (said prior rejection was erroneous based on other grounds as noted in the Applicant’s prior response). The present rejection amounts to improper piecemeal examination. MPEP 707.07(g). “The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph.” TMEP § 2173.05(b) (citing Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d. 818, 221 USPQ 568 (Fed. Cir. 1984)). “Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” MPEP § 2173.05(b) (emphasis added). The Applicant’s Specification (which the office action in Paragraph 2 characterizes as “lengthy” despite being only 29 pages long in double spaced text, and which the office action indicates has not been checked thoroughly) makes it unmistakably clear what is meant by “comparable alternatives”: Firstly, each of Claims 1, 14 and 15 refer to comparable alternative websites. Secondly, page 13 of the Specification at lines 7-19, explains that the system provides the capability for consumers to consider and compare purchase alternatives via a referential directory endowed with links and telephone numbers for “alternative businesses in the same field as the business originally queried.” See also FIG. 6, depicting a sample referential directory of websites and phone numbers for businesses related to the initial query. The “comparison” made to identify “comparable alternatives” is based on customizable criteria as noted in the claims and at page 16 of the Specification. (See lines 9-10 and 15-17). At page 19, the Specification further states: “[v]arious criteria can be used for comparison, including, without limitation, geographic

location, types of products or services, prices of products or services, type of content, date of publication of content or other criteria.” Therefore, “comparable alternative websites” clearly means websites that are considered to be comparable based on one or more of the criteria for comparison specified in the above-referenced excerpts of the Specification, which criteria are also referenced to in Claims 6-11 and Claims 21-26. Minor revisions to the claims have been made in an effort to address the examiner’s Section 112, second paragraph concerns, which should be sufficient for withdrawal of the examiner’s rejections based on Section 112, second paragraph.

Paragraph 6 of the office action asserts that Claims 1-26 are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps, the omitted steps alleged to be means for inputting customizable criteria or the introduction of customizable criteria. The Applicant respectfully requests withdrawal of this rejection firstly because, as noted in MPEP § 2172.01, the basis for said rejection cited, namely 35 U.S.C. § 112, second paragraph is not the provision applied to omission of essential steps, but rather to issues involving interrelation of elements. Omission of essential steps is a 35 U.S.C. § 112 first paragraph enablement issue. This rejection is also one that was not raised in the initial office action. The Applicant respectfully submits that the step alleged to be omitted and essential is not a critical limitation. As clearly noted in Claims 4 and 5, the customizable criteria are provided either by electronic communication from the system user or are preprogrammed into the system. See also page 19, lines 9-10 of the Specification. See MPEP 2164.08(c) (noting that “[b]road language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.”) The way that the customizable criteria are inputted is not critical, and frankly, is not part of the system. To

require such an unnecessary limitation in the claims would unfairly limit the Applicant's claims. It is analogous to requiring that claims directed to any Internet based system require, as limitations, a user-end computer, running power and the Internet itself. For all of the foregoing reasons, the Applicant respectfully requests that the § 112 second paragraph rejections be withdrawn.

Section 102/103 Rejections

The Applicant notes the examiner's rejection of Claims 1-12 and 14-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,853,621 ("Spear") and respectfully requests reconsideration and withdrawal of said rejection in light of the following discussion.

The Applicant respectfully submits that neither the portions of the Spear patent cited by the examiner in the office action nor the rest of Spear anticipates the Applicant's claims. With respect to the Applicant's Claim 1, referring not to the portions of Spear cited by the examiner as the basis for the rejection of said claim, in Column 24, lines 42-50 of Spear the telephone number entered is one that the user wants to call, in the sense of a typical telephone call. The Spear System identifies packet-switched telephony service providers that are available to complete the call, providing a comparison of their rates and terms of service. See Column 24, lines 58-67. In particular, this is explained in Column 24, lines 63-67 — "The listing shows service attributes for packet switched telephony providers offering service to the telephone number...in Nanjing, China shown are the service attributes for Competitor A, Competitor B, Competitor C, Competitor D...." Contrary to the examiner's assertion, Spear nowhere discloses, or suggests for that matter, a system whereby a user can access a specified website and comparable alternative websites utilizing the telephone number of the proprietor of the specified website as search queries comprising means for receiving a system user search query for a

specified Internet website in the form of a telephone number corresponding to said website's proprietor.

On the contrary, in Spear the telephone number used as a query is a telephone number that the user wants to actually call. The user is not looking for a website or to cross-reference merchant phone numbers with their corresponding merchant websites, but rather, is looking for the best way to complete a phone call.

Similarly, contrary to the examiner's assertion, Column 4, lines 41-43 of Spear does not disclose "means for processing said user search query to provide said specified Internet website in response to said query." Lines 41-43 of Column 4 of Spear state that the Spear system service either initiates the call that to the phone number that the user wanted to call using the service provider that is preferred to handle the call, or it simply refers the user/caller to the telephony service provider website for further action to make the call. The Spear server does not provide the user with access to the website corresponding to the party whose telephone number the user wants to call in Spear, but rather Spear provides access to the website of the phone company that can complete the telephone call.

Similarly, Column 24, lines 50-53 of Spear provides a listing of telephony service providers that can complete the call to the phone number specified by the user, not a listing of websites that are comparable to the website of the business or individual that corresponds to the phone number referred to in the user's query.

In simple terms, the clear distinction between the Applicant's invention as claimed and Spear is that in Spear the user is seeking to complete a phone call, and Spear helps to find the best way to do so. In the Applicant's invention the user is looking for a website that corresponds to the same business or person that the user has a phone number for. The user in the Applicant's

invention is not looking to complete a phone call, but instead is looking for goods/services in general on the Internet.

The Applicant's invention provides the valuable phone number to website cross-referencing as well as a listing of websites/numbers of those that are offering either the same types of goods/services, or content or are in the same geographic area, or have competitive prices, or have content published at similar dates (i.e., based on customizable criteria as claimed by the Applicant).

Based on the foregoing, the Applicant respectfully submits that neither Claims 1, 14 or 15 are anticipated by Spear. It logically follows that the dependent claims are not anticipated either, but the Applicant wishes to note for the record the lack of support in the cited portions of Spear for other claim rejections.

As to Claim 2, the examiner asserts in Paragraph 10 of the office action that Column 3, lines 41-46 of Spear disclose means for processing changes to Internet website addresses such that access to said websites is provided in response to user queries using either a prior address or a changed address. This is puzzling. Nowhere in Column 3, lines 41-46 of Spear is such a feature mentioned. Lines 41-46 of Spear read as follows:

“The processor executes a user access application and a database application (which may be the same application), to enable the processor to determine a location corresponding to a telephone number entered by a user at a user device, and transmitted across the packet-switched network to the service.”

This refers to being able to identify what part of the world a user is trying to place a telephone call to based on the telephone number's country and area codes, not updating a change of website address or change in corresponding phone number as with the Applicant's invention.

Similarly, as to Claim 3, there is absolutely no mention of displaying the website content in a standardized format. The rejection completely disregards the wording of the Applicant's claims.

In the rejection of Claim 5, the examiner has himself added the wording desired for the rejection based on this own assumption, not any disclosure in Spear, which is not a proper basis for any Section 102 rejection.

With respect to the rejection of Claim 6, contrary to the examiner's assertions in paragraph 14 of the office action, Column 25, lines 7-9 of Spear say that the service provider attribute information is provided via a hyperlink to the service provider's web page — a hyperlink to a web page is not a database containing the data which is what the Applicant's Claim 6 refers to.

The Applicant further respectfully submits that the examiner has disregarded in the rejections of Claims 7-11 and 22-26 the wording of the Applicant's Claims 7-11 and 22-26 which states that the invention's software applications select additional websites based on comparison of information pertaining to various criteria as noted in such claims. While Spear may disclose a feature where the user can compare listing telephony providers, the Spear software applications themselves do not do a comparison based on customizable criteria to generate the list of telephony service providers in the first place. This difference is of course in addition to those noted above with respect to independent Claims 1, 14 and 15. In sum, Spear actually does not even come close to anticipating the Applicant's invention as claimed and has been misread to set up the rejections that have been made. The Applicant respectfully submits that Claims 1-12 and 14-26 are not anticipated under 35 U.S.C. 102 (e) by the patent cited.

Section 103 Rejection of Claim 13

Claim 13 depends on Claim 12 which in turn depends on Claim 1, which is neither anticipated nor rendered obvious by Spear, for the same reasons noted above. There is no suggestion in Spear, and it was not generally known or old in the prior art as of the Applicant's priority date to cross reference phone numbers to email addresses, including multiple email addresses corresponding to the person or business whose phone number is entered as a query, which is what Claim 13 (incorporating the limitations of both Claims 12 and Claim 1) covers.

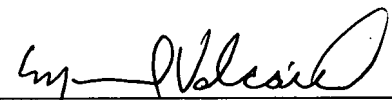
The Applicant respectfully submits that its invention as claimed is not anticipated by or obvious in view of Spear. The Applicant therefore respectfully requests that examiner withdraw the rejection of the Applicant's Claims 1-12 and 14-26 based on 35 U.S.C. Section 102(b) and withdraw the rejection of Applicant's Claim 13 based on 35 U.S.C. Section 103.

The Applicant respectfully submits that the application and claims, as amended, are in condition for allowance. Nonetheless, should the examiner still have any comments, questions or suggestions, the examiner is respectfully requested to telephone the undersigned at the telephone number listed below.

Date: May 14, 2007

Respectfully submitted,

GREENBERG TRAURIG, P.A.
1221 Brickell Avenue
Miami, Florida 33131
Tel: (305) 579-0812
Fax: (305) 579-0717



Manuel R. Valcarcel, Esq.
Reg. No. 41,360